

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF MASSACHUSETTS

IN RE COLUMBIA UNIVERSITY PATENT  
LITIGATION

MDL No. 1592 (MLW)

This Document Relates To All Actions

**APPENDIX TO THE OPPOSITION OF  
BIOGEN IDEC MA INC. AND GENZYME CORPORATION  
TO COLUMBIA UNIVERSITY'S EMERGENCY MOTION  
TO SEAL AND RESTRICT ACCESS**

Dated: June 18, 2004

Donald R. Ware BBO # 516260  
Claire Laporte BBO # 554979  
Carla Miriam Levy BBO # 654212  
FOLEY HOAG LLP  
155 Seaport Boulevard  
Boston, MA 02210-2600  
(617) 832-1000  
Attorneys for plaintiffs BIOGEN IDEC MA  
INC. and GENZYME CORPORATION

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- Tab 12. A letter from Claire Laporte, Foley Hoag LLP, to David Gindler, Irell & Manella LLP, dated June 10, 2004.

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF MASSACHUSETTS

IN RE COLUMBIA UNIVERSITY  
PATENT LITIGATION

MDL No. 1592

This document relates to all actions

**DECLARATION OF CLAIRE LAPORTE**

I, Claire Laporte, declare as follows:

1. I am an attorney licensed to practice in the Commonwealth of Massachusetts. I am a partner at the law firm of Foley Hoag, LLP in Boston Massachusetts, counsel for Biogen Idec MA Inc. and Genzyme Corporation. I base this declaration on my personal knowledge unless otherwise stated.

2. Attached at Tab 1 is a true and correct copy of excerpts from the First Amended Complaint, filed September 24, 2003, in *Immunex, Corp. et al. v. Trustees of Columbia University*, No. CV 03-0349 (C.D. Cal.).

3. Attached at Tab 2 is a true and correct copy an Invoice sent from World Patent Services, Inc. to James Oleson regarding the file histories of U.S. Patent Nos. 6,455,275, 5,179,017, 4,634,665, 4,399,216, and U.S. Patent Application Serial Nos. 08/395,520 and 07/346,089.

4. Attached at Tab 3 is a true and correct copy of a letter from Arthur Wineburg, Pillsbury Winthrop LLP, to DoHoang Tini Duong, Gibson, Dunn & Crutcher LLP, dated June 14, 2004.

5. Attached at Tab 4 is a true and correct copy of a facsimile of a Certified Copy Order Form from World Patent Services, Inc. to the Commissioner of Patent and Trademarks, dated May 10, 2004.

6. Attached at Tab 5 is a true and correct photocopy of a compact disk received by plaintiffs' counsel from the United States Patent and Trademark Office.

7. Attached at Tab 6 is a true and correct copy of a letter from David Gindler, Irell & Manella LLP, to Claire Laporte, Foley Hoag LLP, dated May 27, 2004.

8. Attached at Tab 7 is a true and correct copy of a letter from Claire Laporte, Foley Hoag LLP, to David Gindler, Irell & Manella LLP, dated May 28, 2004.

9. Attached at Tab 8 is a true and correct copy of a letter from Michael J. Cleare, Executive Director, Science & Technology Ventures, Columbia University, to Biogen, Inc., dated Mar. 9, 2004.

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11. Attached at Tab 10 is a true and correct copy of excerpts from Plaintiffs' First Set of Requests for Production of Documents to Defendant The Trustees of Columbia University in the City of New York, dated Nov. 24, 2003.

12. Attached at Tab 11 is a true and correct copy of a letter from Claire Laporte, Foley Hoag LLP, to David Gindler, Irell & Manella LLP, dated June 4, 2004.

13. Attached at Tab 12 is a true and correct copy of a letter from Claire Laporte, Foley Hoag LLP, to David Gindler, Irell & Manella LLP, dated June 10, 2004.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Dated: June 18, 2004

  
Claire Laporte

## **Exhibit 1**

1 ARTHUR WINEBURG, *pro hac vice*  
2 PILLSBURY WINTHROP LLP  
3 1133 Connecticut Avenue, N.W.  
4 Washington, D.C. 20036  
5 Telephone: (202) 775-9800  
6 Facsimile: (202) 833-8491

7 KIRKE M. HASSON #61446  
8 PILLSBURY WINTHROP LLP  
9 50 Fremont Street  
10 Post Office Box 7880  
11 San Francisco, CA 94120-7880  
12 Telephone: (415) 983-1000  
13 Facsimile: (415) 983-1200

14 JENNIE L. LA PRADE #82224  
15 VICKI G. NORTON #175067  
16 PILLSBURY WINTHROP LLP  
17 725 South Figueroa Street, Suite 2800  
18 Los Angeles, California 90017-5406  
19 Telephone: (213) 488-7100  
20 Facsimile: (213) 629-1033

21 Attorneys for Plaintiffs

22 UNITED STATES DISTRICT COURT  
23 CENTRAL DISTRICT OF CALIFORNIA

24 Immunex Corporation, a Washington  
25 corporation, and Amgen Inc., a  
26 Delaware corporation,

27 Plaintiffs,

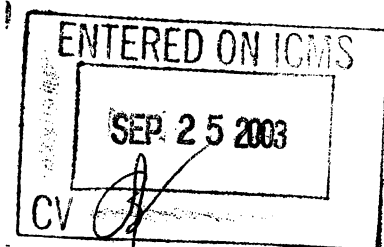
28 vs.

29 The Trustees of Columbia University  
30 in the City of New York, a New York  
31 corporation,

32 Defendant.

No. CV 03-4349MRP(CWx)

FIRST AMENDED COMPLAINT  
FOR DECLARATORY AND  
INJUNCTIVE RELIEF RE:  
CONTRACT RIGHTS,  
INVALIDITY,  
UNENFORCEABILITY AND  
NON-INFRINGEMENT OF U.S.  
PATENT NO. 6, 455, 275



33 For their Complaint, Plaintiffs Immunex Corporation ("Immunex") and  
34 Amgen Inc. ("Amgen") aver as follows:

FILED

2003 SEP 24 PM 3:57  
CLERK U.S. DISTRICT COURT  
CENTRAL DISTRICT OF CALIF.

6

**Introduction**

1  
2           1.     Immunex and Amgen (collectively "Plaintiffs") bring this action for  
3 a declaration that, contrary to the contentions of defendant, The Trustees of  
4 Columbia University in the City of New York ("Columbia"), Plaintiffs do not  
5 owe royalties and fees to Columbia under the license agreement between Amgen  
6 and Columbia, dated as of June 1, 1989, nor the license agreement between  
7 Immunex and Columbia dated as of October 1, 1991, and further that the only  
8 issued extant patent covered by the license agreements, U.S. Patent 6,455,275  
9 ("the '275 patent"), issued September 24, 2002, is invalid, non-infringed and  
10 unenforceable.

11           2.     Columbia has secured four patents from the U.S. Patent and  
12 Trademark Office, all based on the same patent application filed February 25,  
13 1980. The first issued in 1983, and the next two, which issued in 1987 and 1993,  
14 were terminally disclaimed by Columbia so that all three patents expired in 2000.  
15 For license rights under these three patents during their life, pursuant to the  
16 license agreements with Columbia, Amgen and Immunex paid more than 100  
17 million dollars.

18           3.     Columbia also secured corresponding foreign patents from patent  
19 offices in Europe, Canada and Japan, including European Patent No. 045,809, the  
20 national patents based on the European patent, and Japanese Patent No. 5700410.  
21 These patents expired on February 25, 2000, twenty years from their priority  
22 filing date. Columbia also obtained corresponding Canadian Patent No.  
23 1179953, which expired on December 27, 2001.

24           4.     After the three U.S. patents expired on August 16, 2000, Columbia  
25 demanded continued payment of royalties because Columbia had additional  
26 pending patent applications claiming priority to that 1980 patent application.  
27 Columbia thereafter demanded royalty payments, asserting that failure to pay  
28 royalties was a breach of the license agreement.



1           44. Instead, Columbia limited its prospective arguments that the new  
2 claims were free from a double-patenting rejection to distinctions between the  
3 new claims and the '216 patent claims. Even though some of the new claims  
4 related to transformed CHO cells, Columbia failed to raise the previous  
5 Examiner's rejections of transformed cell claims in view of the '017 patent.  
6 Columbia's statements and omissions were material and misleading, because,  
7 among other things, they suggested that the '216 patent was the only basis for a  
8 double-patenting rejection and ignored the prior double patenting rejection based  
9 on the '017 patent. In fact, the Examiner was misled, as he relied only on the  
10 '216 patent as a basis for a double-patenting rejection. As a result of Columbia's  
11 manipulation of the process, and its non-disclosures and misleading statements,  
12 Columbia obtained the '275 patent.

13                   (iv) **During prosecution of the '275 patent, Columbia further**  
14                   **misled the examiners to avoid double-patenting rejections**  
15                   **based on the '017 patent**

16           45. To avoid double-patenting rejections based on the '017 patent,  
17 Columbia further misled the examiners of the '275 patent regarding the related  
18 application, U.S. Application Ser. No. 08/477,159 ("the '159 application) which  
19 it still has pending in the PTO. The '159 application was filed and prosecuted by  
20 the same attorney and law firm that filed the '275 patent, and claims priority to  
21 the same application first filed in February 1980.

22           46. On April 29, 1997, the examiner of the '159 application rejected  
23 claim 135, for obviousness-type double patenting in view of claims in the '017  
24 patent. Claim 135 was drawn to a method of producing a proteinaceous material  
25 by culturing CHO cells. Columbia failed to overcome the '159 examiner's  
26 double-patenting rejection of claim 135 and canceled the claim on August 24,  
27 1998.

28

1           95. This is an exceptional case, and Plaintiffs seek an award of  
2 attorneys' fees pursuant to 35 U.S.C. § 285.

3  
4           WHEREFORE, Plaintiffs pray for judgment against Columbia as follows:

5           a. For a declaration that Columbia's claims for royalties lack  
6 merit, and that no royalties are owed under the License Agreements with  
7 Plaintiffs;

8           b. For a declaration that Plaintiffs do not infringe the '275 patent  
9 and that the claims of the '275 patent are invalid and/or unenforceable;

10           c. For injunctive relief to prohibit Columbia from efforts to  
11 enforce against Plaintiffs the '275 patent or any obligation arising from the  
12 License Agreement;

13           d. For attorneys' fees and costs of suit; and

14           e. For such other, further and additional relief as the Court may  
15 deem just and proper.

16           Dated: September 24, 2003.

17           ARTHUR WINEBURG  
18           KIRKE M. HASSON  
19           VICKI G. NORTON  
20           JENNIE L. LA PRADE  
21           PILLSBURY WINTHROP LLP

22           By Jennie L. La Prade  
23           Jennie L. La Prade  
24           ATTORNEYS FOR PLAINTIFFS  
25           IMMUNEX CORPORATION and  
26           AMGEN INC.  
27  
28

## **Exhibit 2**

**World Patent Services, Inc.**

2001 Jefferson Davis Hwy. Suite 304-B

Arlington, VA 22202

Tel: (703)-418-2848 Fax: (703) 418-3848

E-Mail: wps@world-patent.com

**Invoice**

DATE	INVOICE #
10/17/2002	17613

BILL TO
Foley Hoag James Oleson 155 Seaport Blvd. Boston, MA 02210

**PAID**

TERMS	DUE DATE	CONTRACT #
Net 30	11/16/2002	

DESCRIPTION	AMOUNT
Re: US Patent File Histories: 6455275, 5179017, 4634665, 4399216, 08/395520, 07/346089 Your Ref: 20657-28  1396 Pages of FH @ .75 per page Next Day Air - UPS	1,047.00 56.00
<b>Total</b>	
	\$1,103.00

### **Exhibit 3**



1133 CONNECTICUT AVENUE NW WASHINGTON, DC 20036 202.775.9800 F: 202.833.8491

June 14, 2004

Arthur Wineburg  
Phone: 202.775.9880  
awineburg@pillsburywinthrop.com

VIA EMAIL: [tduong@gibsondunn.com](mailto:tduong@gibsondunn.com)

DoHoang Tini Duong  
Gibson, Dunn & Crutcher LLP  
333 South Grand Avenue  
Los Angeles, CA 90071-3197

In Re: Columbia University Patent Litigation

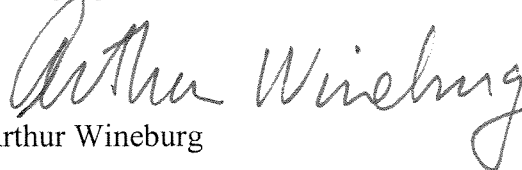
Dear Ms. Duong:

In accordance with Judge Wolf's June 11, 2004 Order and in response to your letter of June 14, please be advised that outside counsel for and in-house counsel of Amgen and Immunex have reviewed the '159 application file. We received copies of documents in the '159 application file from the U.S.P.T.O. as well as from Plaintiff Biogen Corp.

The prosecution of the '159 application was also publicly disclosed in Amgen's complaint with no objection raised by Columbia. See Paragraph 45-49 and Section 72(4) of Amgen's Second Amended Complaint.

Very truly yours,

PILLSBURY WINTHROP LLP

  
Arthur Wineburg

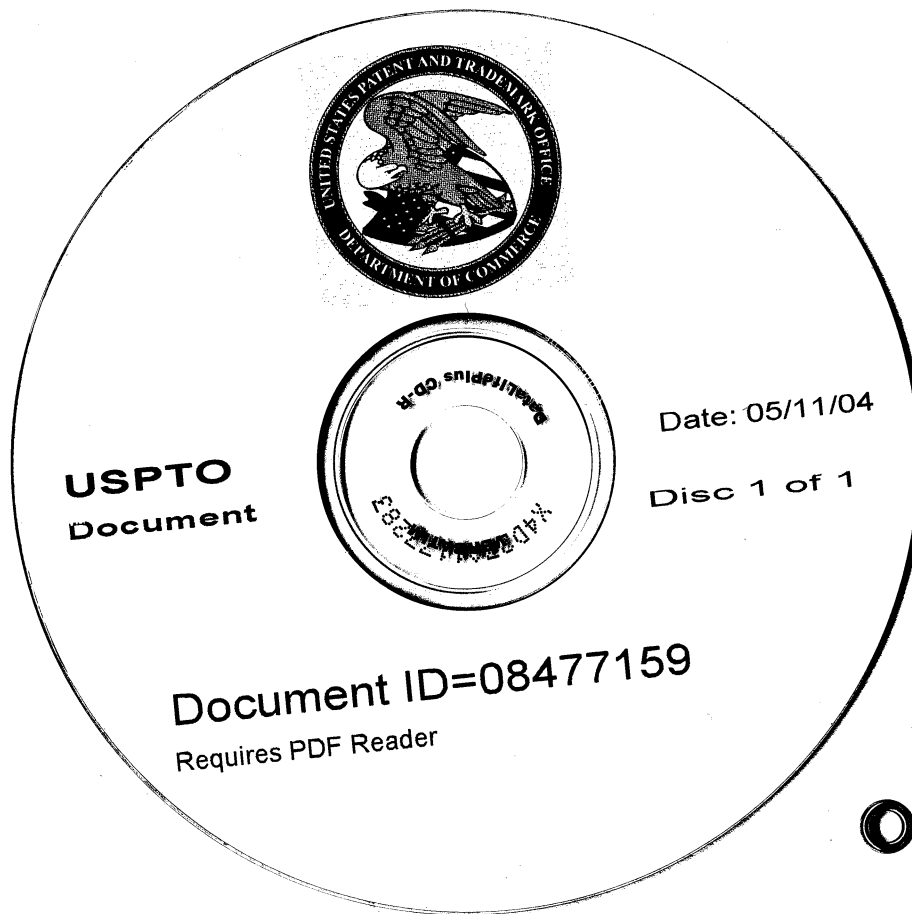
AW:jlt

## **Exhibit 4**





## **Exhibit 5**



## **Exhibit 6**

I R E L L & M A N E L L A L L P

A REGISTERED LIMITED LIABILITY LAW PARTNERSHIP  
INCLUDING PROFESSIONAL CORPORATIONS

840 NEWPORT CENTER DRIVE, SUITE 400  
NEWPORT BEACH, CA 92660-6324  
TELEPHONE (949) 760-0991  
FACSIMILE (949) 760-5200

1800 AVENUE OF THE STARS, SUITE 900  
LOS ANGELES, CALIFORNIA 90067-4276

TELEPHONE (310) 277-1010  
FACSIMILE (310) 203-7199  
WEBSITE: WWW.IR&M.COM

WRITER'S DIRECT  
TELEPHONE (310) 203-7096  
FACSIMILE (310) 202-7199  
jsheasby@irell.com

May 27, 2004

VIA FACSIMILE

Claire Laporte, Esq.  
Foley Hoag LLP  
155 Seaport Boulevard  
Boston, MA 02210-2600

Re: Columbia University

Dear Ms. Laporte:

I write to address two serious issues with regard to the Reply to Columbia's Opposition to Biogen and Genzyme's Motion for a Preliminary Injunction (the "Reply") and the Appendix in support thereof (the "Appendix") submitted by Biogen and Genzyme on May 26, 2004.

First, Exhibit 3 of the Appendix attached substantial portions of the October 27, 2003 Amendment to Columbia's pending U.S. Serial No. 08/477,159 (the "'159 application"). The Reply also quotes a portion of the October 27, 2003 Amendment. In particular, the Appendix and Reply excerpt proposed claims for the '159 application. The prosecution history for the '159 application is confidential. Neither Biogen, Genzyme, nor any other entity is entitled to view the contents of the '159 application prosecution history. By including major portions of the October 27 Amendment in the Appendix and Reply, Biogen and Genzyme have published Columbia's trade secrets without authorization. We ask that you immediately take the following steps: (1) retrieve and destroy all portions of the '159 application prosecution history within the custody or control of Biogen and Genzyme; (2) fully cooperate with Columbia in attempting to recover all copies of any portion of the '159 Application prosecution history released to any other entities; (3) immediately make arrangements with the Court to prevent any entity from obtaining the excerpts from the October 27 Amendment contained in the Appendix and Reply. In addition, please provide answers to the following questions in as much detail as possible: what portions of the '159 application prosecution history are in the possession of Biogen and Genzyme; how did Biogen and Genzyme obtain these portions of the '159 application prosecution history; what other entities possess portions of the '159 application prosecution history, and how did they obtain these portions of the '159 application prosecution history?